

REMARKS

This paper is filed in response to the final office action mailed on April 8, 2004. Claims 5 and 8 have been amended by eliminating the possibility that R₄ is tert-butyl. As admitted in the office action at paragraph no. 7, Otani only exemplifies Formula 2 when R₄ is a tert-butyl group. Thus, the amendments to claims 5 and 8 remove Otani as a base reference.

Applicants respectfully submit that the amendment to claim 5 also traverses the arguments presented in paragraph nos. 8 and 9 of the office action as well.

In paragraph no. 10 of the office action, the patent office admits that Otani fails to teach or suggest the repeating unit b of Formula 2 or the repeating units b or c of Formula 3. Thus, Otani is clearly deficient as a base reference.

In an attempt to supplement Otani in this regard, the patent office relies upon Lee. However, Lee merely teaches a norbornene carboxylate having an acid labile group as a substituent. However, none of the structures disclosed in Lee remotely resemble the structures of Formulas 2 or 3. Further, no combination of the acids labile protecting groups of Otani with the structures of Lee would teach or suggest a structure remotely similar to Formulas 2 or 3 of amended claim 5. Further, even if the hypothetical combination of Lee and Otani were made, Otani would have to be dramatically altered due to the amendment of claim 5 and the exclusion of the tert-butyl group from the possible acid labile protecting groups.

Further, Applicants respectfully submit that Lee could not be easily incorporated by one of ordinary skilled in the art into example 5 of Otani. While norbornene derivatives are well known in the art, the exact structure of the photoresist polymers represented by Formulas 2 and 3 are not taught or suggested by the prior art as evidence by the clearly different structures disclosed in Lee and the very different structures disclosed in Otani. There is an abundance of photoresist polymer art and the failure of the patent office to come up with a reference disclosing the structure remotely similar to Formulas 2 and 3 supports the notion that the hypothetical combination of Otani and Lee set forth in the final office action is based on hindsight, would require modification of each reference and therefore neither reference suggests a combination and in violation of MPEP §§ 2142 and 2143. Further, the hypothetical combinations set forth in the patent office would still not

teach or suggest every claim limitation of claim 5 and therefore the obviousness rejection does not meet the standards of §§ 2142 or 2143 for this additional reason.

Further, Applicants respectfully submit that this amendment is in full compliance with Rule 116 because it raises no new issues, the amendments do not require any additional searching and clearly places this application in a condition for allowance.

In view of the foregoing amendments, applicants respectfully submit that this application is now in a condition for allowance and an early action so indicated is respectfully requested.

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Respectfully submitted,

By

Michael R. Hull

Registration No.: 35,902

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicants